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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/923,694 | 08/07/2001 | Karl Van Blankenburg | AMI-158-B | 1562 |

7590 05/15/2003

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EXAMINER

PHAN, HAU VAN

| | |
|----------|--------------|
| ART UNIT | PAPER NUMBER |
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3618

DATE MAILED: 05/15/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/923,694

Applicant(s)

BLANKENBURG ET AL.

Examiner

Hau V Phan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 May 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 9-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Acknowledgment

1. The request for reconsideration filed on 2/12/2003 has been considered.
2. Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn. An action on the merit's follows.
3. The declaration under 37 CFR 1.132 filed 2/12/2003 is insufficient to overcome the rejection of claims 1-8 based upon the rejected under 35 U.S.C. 103(a) Graf (6,421,934) in view of Reynolds (6,109,622) references as set forth below.
4. It refers only to the system described in the above referenced application and not to the individual claims of the application. Thus, there is no showing that the objective evidence of nonobviousness is commensurate in scope with the claims. See MPEP § 716.
5. The declaration showing is not commensurate in scope with the claim. Claim 1 recites "a holder unitarily formed as part of the sole of the shell, the holder having an opened grooved extending lengthwise thereover" and "a blade received in the opened groove after the holder has been unitarily formed with respect to the shell". In the declaration, the applicant's argument that Graf teaches a skate wherein the blade is insert-molded in the mold before molding of the goalie skate. The examiner disagrees, ^{that the showing is} because Graf does not disclose the method of making a skate boot and how to insert _{commensurate} the blade to the blade holder. Graf in figure 2 appeared to have an open ended groove

(B)
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to received the blade. The applicant also argues over skate strength that are inherent in replaceable blade skates would have taught away from forming a goalie skate having heel and toe portion integral with a blade holder. The opinion evidence praising the merits of the claimed invention were found to have little value because of a lack of factual support.

6. In view of the foregoing, when all of the evidence is considered, the totality of the rebuttal evidence of nonobviousness fails to outweigh the evidence of obviousness.

Election/Restrictions

7. Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-8, drawn to an attachment to a goalie ice skate, classified in class 280, subclass 811.
- II. Claims 9-20, drawn to method for making an attachment to a goalie skate, classified in class 29, subclass 525.01.

8. Inventions I and II are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the process as claimed can be practiced by another and materially different apparatus such as shoe and ice skate.

9. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

10. Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II, restriction for examination purposes as indicated is proper.

11. Newly submitted claims 9-20 directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: Claims 9-20 are drawn to an invention of a method of making attachment to a goalie skate as a non-elected species by original presentation.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 9-20 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 1-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Graf (6,421,934) in view of Reynolds (6,109,622).

Graf in figures 1-2 discloses a skate boot and getting up aid for such a skate boot comprising a protective shell (1) having first and second opposing side walls (4) and a sole (6) joined by toe and heel portions having a first end and a second end. The shell defined an interior cavity adapted for a receiving a goalie ice skate boot. Graf also discloses a holder unitarily formed as part of the sole of the shell. The holder has an open-ended groove (figure 2) extending lengthwise thereover. Graf also discloses a blade (2) received in the open ended groove after the holder has been unitarily formed with respect to the shell. The blade has a blade edge and at least two legs projecting from the blade edge. Graf fails to show and at least two transversely extending bores formed in the holder, apertures formed in the legs and fasteners engagable through the apertures in the legs of the blade and the bores in the holder to removably affix the blade to the holder.

Reynolds in figure 2 teaches an ice skate chassis comprising a holder (1), a blade (79) and fasteners (65). The holder has at least two transversely extending bores (50, 51) formed in the holder. The blade has apertures (70, 71) in legs. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the skate boot and getting up aid for such a skate boot of Graf with the ice skate chassis having at least two transverse bores, apertures and fasteners as taught by Reynolds in order to increase the force opposing deformation of the blade given by the transverse force.

Regarding claim 2, Graf discloses the open-ended groove, which is integrally formed with respect to the toe and heel portions and releasibly engages the blade.

Regarding claim 3, Reynolds discloses the corresponding number of bores (50, 51), which are integrally formed with respect to toe and heel portions (5, 7).

Regarding claims 4-5, Graf discloses at least one slot (figure 1) for receiving at least one lateral support defined by the holder. Wherein the at least one slot is integrally formed with respect to the toe and heel portions.

Regarding claim 6, Graf discloses the first sidewall defines a low profile in at least a central portion of the skate and with corresponding number of bores from Reynolds into the sidewall of Graf. The corresponding numbers of bore are integrally formed with respect to the low profiled of the first opposed sidewall.

Regarding claim 7, Graf discloses the second sidewall defines an ankle portion rising above an upper extend of the heel portion and with corresponding number of bores from Reynolds into the sidewall of Graf. The corresponding numbers of bore are integrally formed with respect to the ankle portion of the second opposed sidewall.

Regarding claim 8, Graf discloses in figure 1 discloses at least one of the aperture formed in the legs and with the number of aperture from Reynolds. The at least one aperture formed in the legs is offset from a substantially longitudinal axis of the corresponding leg.

Response to Arguments

14. Applicant's arguments filed 2/12/2003 and 5/5/2003 have been fully considered but they are not persuasive. In response to applicant's arguments that Graf does not teach or suggest a holder unitarily formed with respect to a shell operable to receive a blade in an open ended groove, the examiner disagrees, because Graf in figure 2 discloses the shell (1) and the holder formed as part of the shell having the opened groove extending lengthwise to received the blade (2). In response to applicant's argument that Graf teaches a skate wherein the blade is insert-molded with respect to the skate. The skate does not define an open-ended groove. An open-ended groove never exist in the skate of Graf in solid form to receive a blade because the blade is insert molded (page 5, applicant's amendment). The examiner disagrees, because Graf does not disclose the method of making a skate boot and how to insert the blade to the blade holder. Graf in figure 2 appeared to have an open ended groove to received the blade.

Conclusion

15. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

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shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hau V Phan whose telephone number is 703-308-2084. The examiner can normally be reached on 7:30AM-4:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Johnson can be reached on 703-308-0885. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9326 for regular communications and 703-872-9327 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

HP
May 13, 2003


BRIAN L. JOHNSON
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600

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